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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,991	10/15/2003	Robert Cantwell	23937-43	7432

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PATRICK W. RASCHE  
ARMSTRONG TEASDALE LLP  
ONE METROPOLITAN SQUARE, SUITE 2600  
ST. LOUIS, MO 63102-2740

EXAMINER
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GROSSO, HARRY A

ART UNIT	PAPER NUMBER
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3781

NOTIFICATION DATE	DELIVERY MODE
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12/06/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

## Office Action Summary

Application No.

10/686,991

Applicant(s)

CANTWELL ET AL.

Examiner

Harry A. Grosso

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7-9, 11, 12, 15, 16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-9, 11, 12, 16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawing objection in the previous Office Action under 37 CFR 1.83(a) has been overcome by the amendment filed September 18, 2007. The objection is withdrawn.

### ***Claim Objections***

Claims 11 and 20 are objected to because of the following informalities: In claim 11 it appears the word "is" should be inserted after "side" in line 1. In claim 20 it appears the word "is" should be inserted after "construction" in line 2. Both claims will be read as such for the purposes of this office action. Appropriate correction is required.

In addition, it has been noted that claims 8, 11, 16 and 20 have been amended from their prior version even though the status identifier identifies them as "previously presented." All claims being currently amended in an amendment paper must be presented in the claim listing, indicating a status of "currently amended," and be submitted with markings as stipulated in MPEP §714 to indicate the changes that have been made relative to the immediate prior version of the claims. Applicant is advised that, while the current claim listing will be considered for the purposes of this office action, these requirements must be met in future submissions or the amendment will be considered improper.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 8, 9, 11-14, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holub et al in view of Dennis et al (6,834,838).

3. Regarding claims 1, 9, 18 and 21, Holub et al discloses an insulated container (Figures 1A-1B, column 2, lines 53-65, column 3, lines 22-30). The top panel (110) has a beverage holder (116, Figure 10A, column 6, lines 17-34). The bottom of the cup holder is of the same material as the lid and, thus, prevents heat transfer. Holub et al does not teach an expandable beverage holder. Dennis et al discloses a beverage holder mounted in a flat panel (Figure 2) with an expandable portion using a telescoping construction (column 4, lines 11-16) that can be raised to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle (Figures 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Dennis et al in the top panel of the container of Holub et al to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle. The beverage holder of Holub et al as modified by Dennis et al extends away from the storage space when expanded.

4. Regarding claims 5 and 19, the beverage holder of Holub et al as modified by Dennis et al is configured to allow heat transfer in that the extendable portion is not specified as an insulating material and would allow some amount of heat transfer.

5. Regarding claim 8, Holub et al discloses the body is coupled to the cover by hinges (115, column 2, lines 57-58).
6. Regarding claims 11 and 20, the beverage holder of Holub et al as modified by Dennis et al is expanded away from the storage space and collapsed using a telescoping construction (column 4, lines 11-16).
7. Regarding claims 12 and 16, the side of the beverage holder of Holub et al as modified by Dennis et al is configured to compress when moved to the collapsed configuration.
8. Claims 1, 5, 7-9, 11-13, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil et al (2005/0072181 A1) in view of Dennis et al (6,834,838).
9. Regarding claims 1, 9, 18 and 21, Mogil et al discloses an insulated container (Figures 1A-1B, 6A, paragraphs 0095 and 0162). The top panel (334) has a beverage holder (342, Figure 6A, paragraph 0162). The bottom of the cup holder is of the same material as the lid and, thus, prevents heat transfer. Mogil et al does not teach an expandable beverage holder. Dennis et al discloses a beverage holder mounted in a flat panel (Figure 2) with an expandable portion that can be raised using a telescoping construction (column 4, lines 11-16) to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle (Figures 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Dennis et al in the top panel of the container of Holub et al to provide better securement for a tall beverage container or allow secure placement of a

beverage container with a handle. The beverage holder of Mogil et al as modified by Dennis et al extends away from the storage space when expanded.

10. Regarding claims 5 and 19, the beverage holder of Mogil et al as modified by Dennis et al is configured to allow heat transfer in that the extendable portion is not specified as an insulating material and would allow some amount of heat transfer.

11. Regarding claim 7, Mogil et al discloses the body of the container is soft-sided and the outer edge of the top would have to be of the same soft-sided construction for the fabric hinge on the back edge of the top and to accommodate the zipper shown in Figure 6A.

12. Regarding claim 8, Mogil et al discloses the body is coupled to the cover by a fabric hinge (paragraph 0105).

13. Regarding claims 11 and 20, the beverage holder of Mogil et al as modified by Dennis et al is expanded away from the storage space and collapsed using a telescoping construction (column 4, lines 11-16).

14. Regarding claims 12 and 16, the side of the beverage holder of Mogil et al as modified by Dennis et al is configured to compress when moved to the collapsed configuration.

***Allowable Subject Matter***

15. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments filed March 19, 2007 have been fully considered but they are not persuasive. Applicant argues that neither Holub et al nor Mogil et al nor Holub et al and Mogil et al as modified by Dennis et al discloses an "expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space." In response, the claim language of the independent claims of the instant application is read by the Examiner to recite an expandable beverage holder expanding either outwardly with respect to the storage space or inwardly with respect to the storage space. The expandable beverage holder of Holub et al or Mogil et al as modified by Dennis et al would have a beverage holder that extends outwardly with respect to the storage space, thus meeting the limitation of the claims.

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Holub et al and Dennis et al are dealing with container holders and Dennis et al teaches the

desirability to have a beverage holder expand upward using a telescoping construction to provide better securement for a tall beverage container. Knowledge of this type of beverage holder would be available to one of ordinary skill in the art.

18. Applicant argues that the combination of Holub et al and Dennis is not obvious because Holub et al and Dennis teach away from the instant invention, Holub et al discloses a lid with cup holders and describes general dimensions for the cup holder and positioning of the cup holders on the lid to facilitate molding, however, Holub et al does not describe any structural limitation or function for the cup holders that would preclude the inclusion of the concept of a telescoping cup holder as taught by Dennis in the top surface of the lid. Dennis discloses a telescoping cup holder that is deployed within a well of a component, such as a console, of an automobile. There is nothing in Dennis that precludes the telescoping cup holder from being deployed within a well in the top surface of a cooler lid. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

19. Applicant argues that the combination of Mogil et al and Dennis is not obvious because Mogil et al and Dennis teach away from the instant invention, Mogil et al discloses a soft sided cooler having a molded lid with cup holders formed in the lid, however, Mogil et al does not describe any structural limitation or function for the cup



holders that would preclude the inclusion of the concept of a telescoping cup holder as taught by Dennis in the top surface of the lid. Dennis discloses a telescoping cup holder that is deployed within a well of a component such as a console of an automobile. There is nothing in Dennis that precludes the telescoping cup holder from being deployed within a well in the top surface of a cooler lid. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). Claim 16 had previously been objected to; however, the amendment of claim 16 to depend on claim 9 rather than claim 15 resulted in its rejection.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Anthony Stashick  
Supervisory Patent Examiner  
Art Unit 3781

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